

REMARKS

Claims 1 and 4-6 are pending. No new matter has been added by way of the above amendments. For instance, claim 1 has been amended to remove the weight percent of component (a) and (b). Claim 1 has also been amended to include the subject matter of claim 2, now cancelled. Accordingly, no new matter has been added.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Issues under 35 U.S.C. § 103(a)

The Examiner has rejected claims 1-6 under 35 U.S.C. § 103(a) as being obvious over JP 4-277575 or JP 4-277576 or JP 4-277578 or JP 4-96915 or GB 1259910. Applicants respectfully traverse.

None of the references cited by the Examiner suggests or discloses the feature of independent claim 1 which requires that the oxygen content be 20% or less. Accordingly, based upon this distinction alone the Examiner has failed to present a valid *prima facie* case of obviousness. This rejection is therefore improper and should be withdrawn.

In the instances when the oxygen content exceeds 20%, which is outside of the scope of the present claims, certain disadvantageous results occur.

First, the methylene ether content increases, heat stability decreases and heat curability increases. This results in it being impossible for the oligomer to function as an additive (as tackifier or vibration damping agent). Namely, an oligomer containing over 20% of oxygen is predicted to form a resol type naphthalene oligomer. If used for a tackifier or vibration damping agent, it is possible to fail to achieve the expected effect in order to react with a base resin (for example SBR).

Second, when the ether group increases, polarity increases and solubility or compatibility with the base resin (for example SBR) decreases. If the oligomer has many polarity groups, it may be impossible to obtain the expected vibration damping agent.

The art cited by the Examiner fails to recognize these disadvantageous properties. This is not surprising since the references fail to recognize the advantages associated with the currently claimed subject matter.

Also, each of the cited references of JP 4-277575, JP 4-277576, JP 4-277578 or JP 4-96915 fail to suggest or disclose the use of the particular material as a tackifier or a vibration dampening agent. Additionally, GB 1259910 fails to suggest or disclose the use of a tackifier or a dampening agent at al.

Accordingly, for this additional reason the Examiner has failed to present a valid *prima facie* case of obviousness.

Moreover, even if the Examiner has hypothetically established a *prima facie* case of obviousness, the present invention achieves unexpected properties when compared to the prior art. Accordingly, these unexpected properties render moot any hypothetical *prima facie* case of obviousness. For instance, the disadvantageous properties associated with subject matter outside of the present invention are as discussed above. Additionally, the properties of being useful as a tackifying and vibration dampening agent are superior results which are not suggested by the prior art. The Examiner is requested to consult the effects of the tackifier according to the present invention as shown in Table 2 and consult Figures 1 and 2 for the results as a use as a vibrating damping agent. Accordingly, these unexpected results rebut any hypothetical *prima facie* case of obviousness.

In summary, Applicants submit that the Examiner has failed to present a valid *prima facie* case of obviousness. Accordingly, the Examiner is respectfully requested to withdraw all rejections and allow the currently pending claims.

If the Examiner has any questions or comments, please contact Craig M. McRobbie, Reg. No. 42,874 at the offices of Birch, Stewart, Kolasch & Birch, LLP at (703) 205-8000 in the Washington, D.C. area.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any

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overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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